



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER 60/120,826 FILING DATE 09/15/93 FIRST-NAMED INVENTOR STEPHEN A. GRATTON ATTORNEY DOCKET NO.

STEPHEN A. GRATTON
10279 GUMBALL PLACE
SAN DIEGO, CA 92131

E6M1/0926

KARLSEN, E

EXAMINER

ART. UNIT 2607 PAPER NUMBER 8

09/26/94

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 6-30-94 This action is made final.

A shortened statutory period for response to this action is set to expire _____ month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 44-49, 51-56, 71-77 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims 1-43, 50, 57-70 have been cancelled.

3. Claims _____ are allowed.

4. Claims _____ are rejected.

5. Claims _____ are objected to.

6. Claims 44-49, 51-56, 71-77 are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____ has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____ ; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1835 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

Art Unit 2607

1. Due to modification of existing claims by amendment and the addition of new claims the requirement to elect of April 7, 1994 is withdrawn and the following requirement to elect substituted therefor:

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 44-49, drawn to an attachment member subcombination of plural probe elements having a substrate, classified in Class 324, subclass 754.

II. Claims 51-56, drawn to an attachment member combination, classified in Class 324, subclass 754.

3. III. Claim 71, drawn to a method of establishing ohmic contact, classified in Class 324, subclass 754.

4. IV. Claims 72-77, drawn to an attachment member subcombination of a single probe element having a semiconductor substrate, classified in Class 324, subclass 754.

5. The inventions are distinct, each from the other because of the following reasons:

6. Inventions I, II and IV in a first set and III in a second set are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

Art Unit 2607

process of using that product (M.P.E.P. § 806.05(h)). In the instant case the apparatus can be used in a process that does not use Z-axis material or in a process that does use Z-axis material.

7. Inventions I and II in a first set and IV~~II~~ in a second set are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the details of the subcombination are not necessary for the combination and claims 44, 51 and others serve as evidence claims that such is the case. The subcombination has separate utility such as by itself for its intended purpose or in different combinations.

8. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the

Art Unit 2607

particulars of the subcombination as claimed because the details of the subcombination are not necessary for the combination and claim 51 and others serve as evidence claims that such is the case. The subcombination has separate utility such as by itself for its intended purpose or in a different combination.

9. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

10. If Group I, Group II or Group IV is elected further election of species is required as follows:

11. This application contains claims directed to the following patentably distinct species of the claimed invention:

1. The species where the raised portion of the contact is an asperity.

2. The species where the raised portion of the contact is a point.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 44, 51 and 72 are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Art Unit 2607

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

12. A telephone call was made to the Office of the Attorney of Record on September 16, 1994 to request an oral election to the above restriction requirement, but did not result in an election being made.

E. Karlsen:lsd
September 20, 1994
703-305-4768

Ernest F. Karlsen
ERNEST F. KARLSEN
PRIMARY EXAMINER
GROUP 267